

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Jerding, *et al.*

Serial No.: 09/692,995

Filed: October 20, 2000

For: **Media-On-Demand Bookmark System**

Confirmation No.: 8091

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No. A-6687 (191910-1570)

REPLY BRIEF UNDER 37 C.F.R 41.41

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Sir:

This is a Reply Brief in response to the Examiner's Answer dated July 17, 2007.

I. STATUS OF THE CLAIMS

Claims 80, 82, 83, 85, 86, and 90-101 remain pending in the present application. The Examiner's Answer maintains the rejections of the claims and generally repeats the arguments advanced in the Advisory Action dated November 27, 2006, in addition to providing comments to the Appeal Brief (in the Response to Argument Section, pages 13-19 of the Examiner's Answer) filed on March 28, 2007. With regard to the substantive remarks of the Examiner's Answer, Appellant respectfully disagrees. Appellant will address some issues raised in the Examiner's Answer. Appellant continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. ARGUMENTS

Appellant addresses the rebuttal comments beginning on page 13 (emphasis added) of the Examiner's Answer in the following sections below, which mirror the section numbers from the Examiner's Answer.

I. Discussion of rejections of claims 80, 82, 83, 85, 86, 90-92, 96-100 Under 35 U.S.C. 103(a) pertaining to White in view of Lewis.

A. Independent Claim 80

On page 13 of the Examiner's Answer, the following allegation is made:

Appellant's invention essentially applies known video playback functionality (i.e. 'bookmarking') such as that found in local video playback devices (i.e. DVD players) to other known video playback systems (i.e. video-on-demand).

Appellant respectfully disagrees. Appellant respectfully submits that claim 80 represents an embodiment of an invention, not "the invention." Further, Appellant respectfully disagrees with such a broad characterization of claim 80, or other claimed embodiments if the intent was to cover those as well with such a such a broad characterization. Appellant respectfully submits that, in contrast to the broad characterization set forth in the Examiner's Answer, the embodiments are defined by the claims.

However, even assuming *arguendo* the accuracy of such a broad characterization, a similar remark may be made of the invention and patent of the electric light bulb. That is, using the same manner of characterization set forth in the Examiner's Answer, it may be said that Thomas Edison applied known physical phenomenon (electricity) to known materials (carbonized filaments and a glass bulb) to "invent" (and indeed, receive a patent on) an electric light bulb, which highlights a well-known truism of patent law, namely that "...generally all combinations are of known elements," Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985) (citations omitted).

Additionally, on page 13, a footnote labeled "2" is set forth, with an explanation of the footnote provided on pages 14 and 15 of the Examiner's Answer that reads as follows (emphasis added):

The question regarding the rejection containing clear legal error was previously raised and found not to be persuasive by the panel in the pre-appeal conference dated 28 February 2006.

Appellant respectfully submits that this conclusion has no basis in the Notice of Panel Decision mailed to Appellant on February 28, 2007. Section 2 of that Decision provides that the "application remains under appeal because there is at least one actual issue for appeal." That is, there is nothing in the Notice of Panel Decision that warrants a conclusion that the "question regarding the rejection containing legal error" was "found not to be persuasive." Quite the contrary, the fact that the box corresponding to Section 2 is checked is an admission by the Panel that there is an issue for appeal. Further, Section 6 of the USPTO OG Notice, dated July 12, 2005, states that the format of the panel decision is one in which the "Office will mail a decision on the status of the application," (emphasis added) and that the decision will state one of four findings, none of which comments or opines on the relative persuasiveness of the arguments presented in the pre-Appeal Brief Conference. Accordingly, Appellant believes the conclusion presented in Examiner's Answer regarding the relative persuasiveness inaccurately represents the decision of the Panel, and in fact is merely an opinion.

Further, Appellant notes that the Examiner's Answer sets forth on page 14 a rule of law that "one cannot show nonobviousness by attacking reference individually where the rejections are based on combinations of references." However, Appellant respectfully notes that *White* and *Lewis* are both addressed in the Appeal Brief, previous responses, as well as the current reply. Further, Appellant respectfully notes that there exists a distinction between addressing in-kind Examiner arguments that are directed to individual references, which Appellant has done and continues to do, and attacking individual references.

In addition, the Examiner's Answer alleges on page 14 that a prima facie case of obviousness has been established. Appellant respectfully disagrees for at least the reason that the first prima facie element presented on page 14 of the Examiner's Answer has not been met. As set forth in the Appeal Brief, Appellant respectfully submits that *White* and *Lewis* fail individually and in combination to disclose, teach, or suggest at least ***receiving a second user input configured to request from the headend the visual scene in the video presentation after the STT has output at least another portion of the video presentation and responsive to receiving the second user input, requesting by the STT that the headend send the video presentation beginning from the requested visual scene***, as recited in claim 80. As is clear from this portion and particularly the antecedent language, a visual scene from a video presentation has been bookmarked and subsequent to that bookmarking, additional video content of that same video presentation has been output from the STT. Further, it is also clear from the explicit claim language that the second input requesting the scene has been received after this additional video content has been received, and that the STT requests the delivery of the same video presentation from the headend of that bookmarked scene. The Examiner's Answer and previous rejections clearly ignore the explicit language of claim 80, and likewise, the sequence of events and interactions between the headend and STT flowing from the claim language.

Additionally, Appellant respectfully submits that the Examiner's Answer on page 15 presents Appellant's Appeal Brief arguments out of context, which Appellant respectfully

submits serves to confuse the issues. For instance, on page 15 of the Examiner's Answer, the following allegation is made (emphasis added):

Contrary to appellant's broad assertion that no content from a given presentation is delivered by the headend after a pause or stop, it is respectfully noted that the White [sic] makes several references to 'resuming playback' (thereby displaying video content after a "pause", "stop", or other interruption) (ex. Col 4, Line 65-Col 5, Line 9 and Col 5, Lines 16-21).

Appellant respectfully submits that this statement misrepresents Appellant's arguments. Appellant has reproduced below the arguments presented in the Appeal Brief for claim 80 pertaining to the pause/stop function of *White* (no emphasis added):

Once the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of content from the given video presentation as claimed in claim 80. (Page 9 of the Appeal Brief)

In the Advisory Action dated November 27, 2006 (Continuation sheet), the Examiner alleges that *White* "clearly include[s] the particular output of multiple portions of a video both prior to and subsequent to the various playback commands." Applicants respectfully submit that *White*, which appears *arguendo* to describe stop and pause functions in the context of interaction between a headend and a client (and not bookmarking functions), does not show the multiple portions of video as claimed since, as explained on pages 11-12 in Applicants' response dated November 8, 2006, once the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of content until resumption from the scene from which the interruption was commenced. That is, the system in *White* does not show that a previously bookmarked visual scene can be requested by the STT and delivered by the headend after the headend has delivered content from the same presentation beyond that bookmarked scene since, according to *White*, no content from a given presentation is delivered by the headend after a pause or stop. (Page 10 of the Appeal Brief)

These reproduced sections of the Appeal Brief clearly point out the failure of prior Office Actions to support obviousness of the explicit claim language of claim 80, and in particular, the lack of attention to the sequence of events required by the antecedent language of the claim, and the recited interactions between the STT and the headend. These reproduced sections also reveal that the pause/stop function of *White* is not the same as or equivalent to the bookmarking as claimed. Even assuming *arguendo* the system in *White* can "resume playback" after a stop or pause, that point is irrelevant. What is relevant, among other points, is that the system in *White* clearly fails to meet the explicit language of claim 80, and

to the extent the Examiner's Answer and previous Office Actions rely on *White* to allegedly show the claim language and this dynamic sequence of interactions between the headend and the STT, a prima facie case of obviousness has not been established for claim 80. Hence, the rejection should be overturned.

Additionally, the Examiner's Answer alleges the following on pages 15-16 (no emphasis added):

While Lewis does not make any explicit reference to VOD systems or networks, as argued by appellant, it is clear to those skilled in the art that the teachings of Lewis are not limited to the exemplary embodiment but may be employed in any digital video apparatus. It is respectfully noted for the panel's review that the reference explicitly discloses that its teachings may be used in any digital video apparatus capable of processing digital video (Page 3, Lines 14-21).

Appellant reiterates that there is simply no teaching of VOD systems or networks in *Lewis*. *White* does not teach bookmarking, and *Lewis* does not teach anything about VOD or communicating over a network with a headend. Appellant notes that the Examiner has denied Appellant the benefit of priority to prior filed applications that show VOD architectures and bookmarking, yet insists that the mere mention in *Lewis* that the "teachings may be used in any digital video apparatus" in combination with *White*, which does not teach bookmarking, allegedly supports an obviousness-type rejection. Appellant simply finds these two positions to be inconsistent and untenable.

The Examiner's Answer alleges the following on page 17, reproduced in relevant part:

In response to applicant's argument that it would not have been obvious to combine *White* and *Lewis*, the examiner respectfully disagrees. In describing the 'bookmarking', the application states:

"Using fast forward and rewind features to access the more desired portions of a video presentation are inconvenient and time consuming. Therefore, there exists a need to provide users with means for easily and conveniently access[sic] portions of video presentations that users desire"

...

Both *White* and *Lewis* are analogous art in that both relate to the field television systems. *Lewis* is also analogous because it is reasonably pertinent to the problem being solved, namely the selection of a particular portion of video for playback without having to rewind/fast-forward through the presentation. There is also a suggestion or motivation, in the references to modify the reference or to combine the reference teachings (*Lewis et al.*: Page 2, Lines 4-14; Page 3, Lines

14-21). Therefore, the second criteria for establishing a prima facie case of obviousness has been met.

Appellant respectfully disagrees. Appellant believes that the intent of the above-cited section from Appellant's application may be more illuminating if the first two sentences of the paragraph from which the citation was taken are included, as reproduced below in addition to the above cite (emphasis added):

Media-on-demand providers present users with video presentations, such as movies, via DHCT's. Many users who request a video presentation are more interested in watching certain portions of said video presentation and less interested in watching other portions. Using fast forward and rewind features to access the more desired portions of a video presentation are inconvenient and time consuming. Therefore, there exists a need to provide users with means for easily and conveniently accessing portions of video presentations that users desire.

Hence, one problem to be solved is more aptly described in the context of headend-supplied VOD (from media on-demand providers), and not in the vacuum of a digital video apparatus with no apparent provider-interactive capability per *Lewis*. Further, given the inability of *White* to bookmark a video presentation, to advance content from the same video presentation beyond the bookmark, and then to return to the same, it cannot be said that *White* advances a solution to the problem expressed in the background of Appellant's disclosure. Indeed, *White* appears to address the need for seamlessly integrating web content with cable TV, or more particularly, "in one aspect, the invention provides a video entertainment system in which conventional television programming and novel interactive entertainment are presented in an integrated fashion, with the user being able to seamlessly switch from one to the other without a disruptive change in context or in production sophistication." (see "Background and Summary of the Invention," *White*). In view of what *White* teaches as a problem, a pause function would appear to be a more reasonable approach to avoiding the "disruptive change in context" than a bookmarking feature, where in the latter instance context may be temporarily lost. Accordingly, Appellant respectfully

submits that there is not a motivation to combine the reference as alleged in the Examiner's Answer.

The Examiner's Answer alleges the following on pages 17-18 (no emphasis added):

Finally, with respect to there existing a reasonable expectation of success, appellant argues that it would not have been reasonable to combine the teachings of *White* and *Lewis* because there is considerable complexity involved in bookmarking content from the headend of the VOD network. Appellant, however, provides none of the necessary evidence of secondary considerations supporting why the fact that purported considerable complexity would dissuade one having ordinary skill in the art due to the combination simply by virtue of being too complex.³ As previously noted and applied in previous grounds of rejection, the concept of implementing bookmarking playback functionality in a video-on-demand system is not too complex but is within the ordinary skill in the art as evidenced by *Budow* (US Pat No. 5,625,864) and *Goode et al.* (US Pat No. 6,166,730) (see Non-Final Rejection, mailed 05 December 2003). Given the predictable nature of the video distribution art as well as the concept of implementing 'bookmarking' functionality in video-on-demand systems being within the ordinary skill in the art, it is the examiner's opinion that there would have existed a reasonable expectation of success.

Appellant respectfully disagrees. Appellant notes that the use of *Goode* and *Budow* still fails to teach the particular bookmarking functionality as claimed. For instance, although both *Budow* and *Goode* uses the term "bookmark," it is not the same as, or equivalent to, the bookmarking as claimed, since like *White*, both *Goode* and *Budow* fail to return to a bookmarked scene of a video presentation after presenting content from the same presentation. Accordingly, a reasonable expectation of success is not advanced through the use of *Goode* and *Budow* in view of the shortcomings shared at least in part with *White*.

Additionally, in response to the footnote that the "arguments of counsel cannot take the place of evidence in the record," Appellant respectfully notes that the evidence of record indeed is a basis for Appellant's assertion that "there is considerable complexity involved in bookmarking content from the headend of a VOD network that is not addressed in either of the prior art references." That is, Appellant's disclosure (as filed) of the complex VOD and STT infrastructure, in comparison with the disclosures of *Lewis* and *White*, is sufficient to enable one having ordinary skill in the art to come to the conclusion that there is a considerable difference in complexity between *White* and *Lewis* and Appellant's disclosure. As set forth in MPEP 2142 (emphasis added):

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

Further, Appellant respectfully notes that there is no requirement that secondary considerations be set forth in Appellant's response to an allegation of obviousness.

B. Independent Claim 96

No additional arguments are presented by Appellant over and above those previously presented. Appellant respectfully continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

II. Discussion of Rejections of claims 93-95 and 101 Under 35 U.S.C. 103(a) pertaining to White, in view of Lewis, and in further view of Wang or Dunn.

A. Dependent Claim 93

Appellant appreciates the Examiner's understanding that the improper recitation of *Wang* in Appellant's arguments as opposed to *Dunn* is considered a mere typographical error. No additional arguments are presented by Appellant over and above those previously presented, except for the substitution of *Dunn* for *Wang* as a reference. Appellant respectfully continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

B. Dependent Claim 94

No additional arguments are presented by Appellant over and above those previously presented. Appellant respectfully continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

C. Dependent Claim 95

No additional arguments are presented by Appellant over and above those previously presented. Appellant respectfully continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

D. Dependent Claim 101

No additional arguments are presented by Appellant over and above those previously presented. Appellant respectfully continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

III. CONCLUSION

Based upon the foregoing discussion, Appellant respectfully requests that the Examiner's final rejection of claims 80, 82, 83, 85, 86, and 90-101 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 20-0778.

Respectfully submitted,

/dr/

David Rodack
Registration No. 47,034